

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
George Telfer

Application No.: 10/550,531

Confirmation No.: 3131

Filed: July 12, 2006

Art Unit: 3672

For: DUAL FUNCTION CLEANING TOOL

Examiner: C. R. Hutchins

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Final Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,275,939 (“Baker”), and claims 13, 15-16, and 19-20 under 35 U.S.C. § 102(b) as being anticipated by International Publication WO1998035131 (“Telfer”). Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Telfer, in view of Baker. In response to the Examiner’s final rejection, Applicant respectfully asserts that all of the rejected claims are allowable.

I. Baker fails to disclose a device that provides a polishing action

To anticipate, *every element and limitation* of the claimed invention must be found in a single prior art reference, arranged as in the claim.” *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (emphasis added). Thus, to form a proper rejection under 35 U.S.C. § 102(b), Baker must include each and *every element and limitation* of the claim as arranged. Further, in order to anticipate, “the [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.” *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

Applicant has previously presented various arguments against Baker, including that Baker fails to teach each and every limitation of amended claim 1. (Response dated June 6, 2008 ["Response"], pg. 8). The Examiner refutes these arguments in large part by concluding, "Baker teaches a scraper that is *capable of* providing both a scraping and a polishing action depending on the position of the cleaning element. (Final Action dated September 30, 2008 ["Final Action"], pg. 6). Applicant respectfully disagrees.

First, Baker is completely silent with respect to providing a cleaning tool having cleaning elements in a first position, such that the cleaning elements provide a polishing action (hence the Examiner's conclusion that Baker's is "capable of" providing polishing). Second, the Examiner overlooks the fact that Baker expressly states that the tool is capable of providing *only* a "scraper *capable of* scraping a film or cement," where "each blade is *capable of* moving both inwardly and outwardly **for the purpose of** maintaining the edges **always** in contact with the casing..." (Baker, pg. 1, col. 1, L1-6; pg. 2, col. 1-2, L74-3) (emphasis added).

Furthermore, Baker expressly describes the *design* of the scraper blades in a manner that does not promote a conclusion that the blades are capable of providing a polishing capability. For example, when the scraper blades of Baker encounter a restriction (*e.g.*, blades forced to transverse from a first position to a second position), the tool/blades will either move past the restriction *or* drill through the restriction/obstruction. (Baker, pg. 2, col. 1, L53-68). In addition, the Baker design is specific for scraper blades used *only* for scraping cement from the casing wall. (See Baker, pg. 2, col. 2, L24-27, L35-39, & L48-54). Applicant also points out that *every* claim in Baker is directed towards a *casing scraper* yieldably in engagement with the wall of a well casing during operation of said *casing scraper*. (See Baker, claims 1-8). Lastly, Baker could not be used for polishing because the cutting edges on the blades are specifically "adapted to cooperate with the wall of the casing..." (Baker, pg. 1, col. 2, L25-20).

In contrast, Applicant's Figure 2 shows a multi-positionable cleaning element that may *scrape* a casing surface (24a with 70) and *polish* a second surface (24b with 64). (Applicant's specification, paragraphs [0047], [0048]).

Thus, Baker's disclosure would not permit a person of ordinary skill in the art to have in their possession a device that provides a scraping action *and* polishing action as required by claim 1, rendering the Examiner's conclusion that Baker's device is 'capable of' providing a polishing action as erroneous.

II. Telfer fails to disclose cleaning elements for polishing a PBR

Applicant has previously argued Telfer fails to teach each and every limitation of amended claim 13. (Response, pg. 10). In general, Applicant has pointed out that Telfer fails to teach or disclose a method for cleaning a liner top that includes cleaning an inner surface of a polished bore receptacle ("PBR") with cleaning elements, as required by amended claim 13. (Response, pg. 10). Specifically, Applicant argued the scraping (cleaning) elements used in Telfer never enter the PBR because they are positioned *above* a junk bonnet that is locked to the PBR. (Response, pg. 10). The Examiner refutes this argument by stating the junk bonnet *can be* inserted into the PBR (as shown in Figure 9A), such that Telfer *does teach* cleaning the PBR (with scraping elements) by reciprocating the tool. (Final Action, pgs. 6-7). Applicant respectfully disagrees.

First, the Applicant never made the argument that the junk bonnet does not enter the PBR; the Applicant's argument is that the cleaning elements *above* the junk bonnet do not enter the PBR. (*See* Response, pg. 10). As clearly shown by Figure 9A of Telfer, the junk bonnet 252 is disposed at the very top of the PBR 250. Indeed, this is to effect the hydraulic lock as explained throughout Telfer. (Telfer, pg. 7, L23-35; pg. 8, L24-30; pg. 14, L19-30, etc.). As a

result of the bonnet being disposed at the *top* of the PBR, it logically follows that any portion of the drill string *above* the bonnet *is not* disposed in the PBR. This makes sense because the cleaning elements in Telfer are used for cleaning the casing located *above* the PBR/liner, after the tool is disconnected from the liner and as the drill string is raised. (See Telfer, pg. 2, L16-30).

Second, Telfer does not expressly disclose using the cleaning elements within the PBR. In particular, the scraper mounted above the junk bonnet is used for scraping the interior surface of the *casing*, not for cleaning the PBR. (Telfer, pg. 24, L6-28). Thus, the Examiner erroneously concludes the cleaning elements 505 on scraper 500 are inserted into the PBR in order to clean the PBR, and subsequently moved outwardly from the PBR to contact and clean the casing. (Final Action, pg. 3).

III. The combination of Baker and Telfer is impermissible

Applicant points out that dependent claims 17 and 18 should now be allowed in light of the arguments presented above for independent claim 13. Additionally, as previously argued by Applicant, both Telfer and Baker do not disclose all of the limitations presented in claims 17 and 18 (which include all of the limitations of claim 13). (Response, pgs. 11 and 12). With respect to claim 18, Applicant notes the Examiner first admits Telfer *does not* specifically teach the step of running a tool back into a PBR. (Final Action, pg. 5). The Examiner then immediately asserts Telfer *does* suggest running the tool back into the PBR. (Final Action, pg. 5). Applicant also previously argued that neither Telfer nor Baker disclose a cleaning tool used in a PBR, or a multi-functional blade that may perform scraping *and* polishing. (Response, pg. 11).

Applicant respectfully notes that in order to establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine the referenced teachings and a reasonable


expectation of success. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). In this respect, the Examiner fails to consider the design limitations that a device of Telfer, modified by Baker, would incur. Significantly, Telfer teaches a *non-rotatable, stationary* scraping tool, whereas Baker teaches a *rotatable* scraping tool. (*Compare* Telfer, pg. 24, L23-33, *with* Baker, pg. 1, L3-4). Telfer does disclose blades rotatably mounted on a bearing device; however, the blades become *stationary* when they contact the casing wall and the drill string is rotated. (Telfer, pg. 24, L23-33). In contrast, Baker does not have a bearing device, and is directed to a *rotating* scraping action imparted by rotation of the drill string. (See Baker, pg. 1, L3-4; pg. 2, L38-53). Thus, there is no suggestion or motivation to combine references with a reasonable expectation of success because the resultant device teaches away from what Telfer and Baker teach separately.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (17172/030001).

Dated: January 16, 2009

Respectfully submitted,

By 
Jeffrey S. Bergman
Registration No.: 45925
OSHA · LIANG LLP
909 Fannin Street, Suite 3500
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant

Attachments